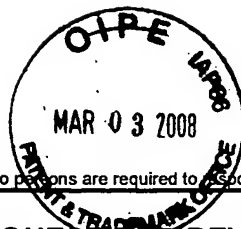


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PTO/SB/33 (07-05)

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

915-001.037

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on February 26, 2008Signature Typed or printed name Lissette Ramos

Application Number

10/509,402

Filed

Sep. 23, 2004

First Named Inventor

M. JAAKKOLA

Art Unit

2618

Examiner

Tuan PHAM

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

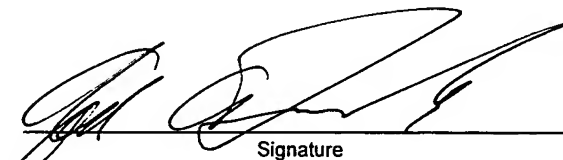
I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record. 27,550
Registration number

☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____



Signature

Alfred A. Fressola

Typed or printed name

(203) 261-1234

Telephone number

February 26, 2008

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒ Total of ONE forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application Of:

M. JAAKKOLA : Confirmation No.: **5708**
Application Serial No.: **10/509,402** : Group/Art Unit: **2618**
Filing Date: **September 23, 2004** : Examiner: **Tuan PHAM**
Title: ***Personal Telecommunication Device with Two Parts and Pronounced Potential for Self-Expression***

Commissioner of Patents
Mail Stop: AF
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

This Request for Review is filed in response to the final Official Action of September 26, 2007. Claims 1-26 were examined by the Office and claims 1-26 were rejected. Applicant respectfully requests review of the final rejection to the claims. The Office is believed to have committed clear error by failing to establish that the cited references, Kanesaka, et al (hereinafter Kanesaka), Marshall, and Morton, in combination, suggest each of independent claims 1, 17, 23, and 25. All of the dependent claims are distinguished over the cited art in view of such dependency.

I hereby certify that this communication is being deposited with the United States Postal Service today, February 26, 2007, in an envelope with sufficient postage as first-class mail addressed to the Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450.



Lissette Ramos

REMARKS

Overview of the Present Invention

The present invention is directed to a personal telecommunication device as shown in Figure 1. It comprises two mechanically separated parts with a short distance communication link 106 therebetween. A first of these two parts is a keypad 102 for allowing a human user to input information to the personal telecommunication device and a second part is an amulet 101 having a display for displaying information to a user, as well as to allow the user of the device to self-express himself/herself, the amulet further comprising a hanging arrangement for allowing the amulet to be worn on the torso of the human user, as well as a microphone and an electroacoustic transducer for setting up an audio interface between the personal communication device and the user.

Thus, a key aspect of the present invention is that the amulet is separate from the keypad and due to the hanging arrangement is provided so as to be directed away from the user of the device so as to allow the user to self-express himself/herself via the display. In short, the telecommunication device via its amulet and associated display provides a form of self-expression previously unknown with regard to telecommunication devices.

Claim Rejections - 35 USC §103

At section 3, independent claims 1 and 23 are rejected in view of Kanesaka further in view of Marshall and Morton. With respect to claim 1, the Office asserts that Kanesaka has the same elements as the present invention except that Kanesaka fails to teach that the amulet comprises a microphone and speaker for setting up an audio interface between the personal telecommunication device and a human user, which the Office asserts Marshall shows, and further that Kanesaka and Marshall fail to teach the display as directed away from the human user to allow the human user to self-express himself/herself, which the Office asserts Morton teaches.

Kanesaka is directed to an information processing system and thus is in the field of personal communication devices. As shown in Figure 1, it illustrates a second information processing device 101 with a second display 120. This second device is stated as being for displaying second level information corresponding to a sub-level of the first level of information shown on display

110 of portable telephone 100. There is no teaching or suggestion that this second display is for purposes of self-expression of the person using the device.

Marshall is directed to a portable information storage module whose main purpose is to offer a means for a user to personally entertain himself/herself with media such as a movie or music that is stored on a miniature electronic memory in the device and which is downloaded from an entertainment library 30 (see Figure 1). The device, including that shown in Figure 8, is not a personal telecommunication device.

Morton is unlike both Kanesaka and Marshall in that it is directed to a medical information storage and display device, the main purpose being to identify the person that wears the device, as well as their medical information so as to be viewable by medical personnel when required. Although display 28 shown in Figure 3 of Morton as discussed in cited paragraph [0029] is for purposes of displaying medical information, it is clear that such medical information is displayed by pressing button 30 and is for purposes of providing information to a doctor or other medical personnel, especially if the user of the device is incapacitated. Thus, such a display is clearly not for purposes of self-expression since, in fact, it is an electronic identification tag.

Furthermore, although Marshall teaches a portable entertainment device having a display and an associated speaker and microphone, it is unrelated to a personal telecommunication device. Consequently, even if the three references are combinable in the manner as suggested by the Office -which applicant disputes as presented below- they would not teach all of the elements of claim 1 in that there is no teaching in any of the references of an amulet having a display to be worn on the torso of a user so as to be directed away from the user so as to allow the user to self-express himself/herself and that the amulet further comprises a microphone and an electroacoustic transducer for setting up an audio interface between the personal telecommunication device and a user. It is therefore respectfully submitted that claim 1 is distinguished over the cited combination of references.

For similar reasons, independent personal communication device claim 23 is distinguished over the cited references.

The same references are applied, but in a different order, with regard to independent claims 17 and 26 at section 4 of the final Official Action. However, as discussed above with regard to claim 1, the combination of these three references fails to disclose the combination of elements,

including the feature of a hanging arrangement for allowing the amulet part to be worn on the torso of a user so that the display is directed away from the user to allow the user to self-express himself/herself via said display of said amulet. It is therefore respectfully submitted that claim 17 is distinguished over the cited art.

For similar reasons, independent amulet part claim 25 is distinguished over the cited art.

Furthermore, the Office has not established why the three references cited are in fact combinable in the manner relied upon by the Office. In the present rejection, the art of the three cited references is quite different from each other as noted above and the Office has failed to show why any of the rationales annunciated in view of the recent decision of *KSR International vs. Teleflex Inc.*, 550 US ___, 82 USPQ2d 1385 (2007), as now set forth in Guidelines promulgated by the USPTO on October 10, 2007 (Fed. Reg. Vol 72, No. 195, October 10, 2007, pages 57526-57535), apply to this application.

The seven rationales as specified at page 57529 of the Guidelines are representative of the type of rationale the Office should show for combining references. In fact, the Office has failed to meet any of these rationales since: there is no showing that combining the prior art elements according to known methods would yield predictable results; there is no showing that simple substitution of one element for another would obtain predictable results; there is no showing that there can be use of known techniques to improve similar devices in the same way; there is no showing that applying a known technique to a known device ready for improvement to yield predictable results; there is no showing of an "obvious to try" rationale of choosing from a finite number of identified, predictable solutions with a reasonable expectation of success; there is no showing that known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art; and there is no showing of some teaching, suggestion or motivation in the prior art that would lead one of ordinary skill to modify the prior art reference or combine prior art reference teachings to arrive at the claimed invention. In fact the Office merely states that Marshall teaches such "features" (these features including that Kanesaka fails to teach the amulet comprises a microphone and speaker for setting up an audio interface between the personal telecommunication device and a human user) and that

Morton teaches such additional features (a display being directed away from a human user to allow the human user to self-express himself/herself via the display of the amulet).

As such, it is respectfully submitted that the Office has failed to adhere to the examination guidelines as noted above with respect to both the selection of the prior art and the analysis of such prior art to show a rationale for obviousness.

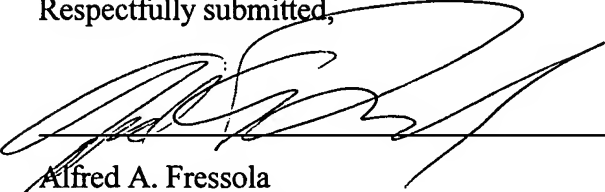
For this reason as well, it is respectfully submitted that a showing for the combination of the references is no more than a hindsight reconstruction based upon the elements of the claimed invention.

Conclusion

The rejection of the final Official Action having been shown to be inapplicable, withdrawal thereof is requested and passage to issue of the present application is earnestly solicited.

The undersigned hereby authorizes the Commissioner to charge deposit account 23-0442 for any fee deficiency required to submit this response.

Respectfully submitted,



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Attorney for Applicant
Registration No. 27,550

Dated: February 26, 2008

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